

REMARKS

After entry of this Amendment, claims 1-3, 5-7, 15-17, 25, and 27-44 are pending in the application. No claims have been amended. The specification has been amended to be consistent with the disclosure of the inherent function disclosed in the drawings as originally filed. Reconsideration of the application as amended is requested.

In the Office Action dated July 24, 2003, the Examiner objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. The Examiner indicated that correction of the following was required: the specification does not disclose means for preventing rotation of the plastic annular sleeve with respect to the housing, as recited in new claims 29, 33, 37, and 41; and does not disclose means for preventing rotation of the plastic thrust member with respect to the housing, as recited in new claims 31, 35, 39, and 43. The Examiner also rejects claims 29-44 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement for the same reasons. It is submitted that this After Final Amendment includes an amendment to the specification to incorporate a written description of the function inherently disclosed in the drawings as originally filed (see Figures 1-5). In cases involving predictable factors, such as mechanical or electrical elements, a single embodiment provides broad enablement in the sense that, once imagined, other embodiments can be made without difficulty and their performance characteristics predicated by resort to known scientific laws. *See In re Fisher*, 427 F.2d 833, 166 USPQ 18 (C.C.P.A. 1970). The C.C.P.A. has described the general test for determining whether a drawing can constitute an adequate written description of the invention under §112, first paragraph as follows:

The practical, legitimate enquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art. Whatever it does disclose may be added to the specification in words without violation of the statute and rule which prohibit "new matter," 35 U.S.C. 132, Rule 118, for the simple reason *that* what *is* originally disclosed cannot be "new matter" within the meaning of this law. If the drawing, then, contains the necessary disclosure, it *can* "form the basis of a valid claim."

See in re Wolfensperger, 302 F.2d 950, 133 USPQ 537 (C.C.P.A. 1962) (emphases in original). The C.C.P.A. has also stated the following general rule for determining when subject matter is inherently disclosed in the specification:

By disclosing in a patent application a device that inherently performs a function, operates according to a theory, or has an advantage, a patent applicant necessarily discloses that function, theory or advantage even though he says nothing concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter.

See in re Smythe, 480 F.2d 1376, 178 USPQ 279, 285 (C.C.P.A. 1973). In the present application, original drawing Figures 1-5 illustrate first gate 46 and second gate or runner 48 extending at an angle generally transverse to the sleeve 32 and corresponding thrust bearing 34. When molded, the structure inherently defines means for preventing rotation of the sleeve 32 with respect to the housing 12, and means for preventing rotation of the thrust bearing 34 with respect to the housing. Therefore, the specification of the present application can be amended to include a written description of the invention consistent with that disclosed in the original drawing figures. Reconsideration of the Examiner's objection to the specification in rejection of claims 29-44 under 35 U.S.C. §112, first paragraph, is requested.

A Notice of Appeal accompanies this After Final Amendment, it appeals the Examiner's Final Rejection of claims 1-3, 5-7, 15-17, 25, and 27-44. Entry of the present amendment to the specification simplifies the issues on appeal by eliminating the Examiner's rejection of claims 29-44 under 35 U.S.C. §112, first paragraph. Entry of this amendment does not require any additional consideration on the part of the Examiner, or any additional search.

It is respectfully submitted that this Amendment traverses and overcomes all of the Examiner's objections and rejections to the application as originally filed. It is further submitted that this Amendment has antecedent basis in the application as originally filed, including the specification, claims and drawings, and that this Amendment does not add any new subject matter to the application. Reconsideration of the application as amended is requested. It is respectfully

Application Serial No. 09/467,530
Date October 24, 2003
Reply to Office Action dated July 24, 2003

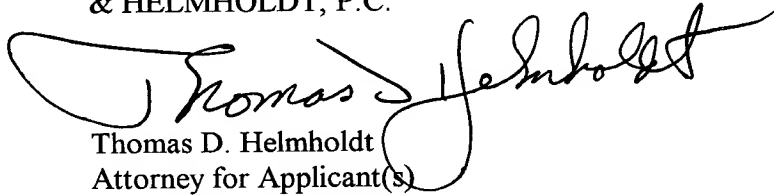
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submitted that this Amendment places the application in suitable condition for allowance; notice of which is requested.

If the Examiner feels that prosecution of the present application can be expedited by way of an Examiner's amendment, the Examiner is invited to contact the Applicant's attorney at the telephone number listed below.

Respectfully submitted,

YOUNG, BASILE, HANLON, MacFARLANE, WOOD
& HELMHOLDT, P.C.

A handwritten signature in black ink, appearing to read "Thomas D. Helmholdt", is written over the printed name and title.

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Dated: October 24, 2003
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